

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicant would like to thank the Examiner for the indication that claim 2 is allowed and claims 4-10 are allowable.

In the Official Action, the Examiner rejects claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,350,391 to Iacovelli (hereinafter "Iacovelli").

In response, independent claim 1 has been amended to clarify its distinguishing features. Claim 3 (as have claims 4-10) has been amended to be consistent with amended claim 1.

Claim 1 has been amended to recite "wherein when the operation section is moved in the three-dimensional direction, the treatment section is moved so that the elongate axis of the treatment section is kept substantially parallel with the elongate axis of the operation section." The Applicant respectfully submits that Iacovelli does not disclose or suggest such a feature. The amendment to claim 1 is fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of the present amendment to claim 1. As discussed above, claim 3 (as well as claims 4-10) has been amended to be consistent with amended claim 1.

With regard to the rejection of claims 1 and 3 under 35 U.S.C. § 102(b), a surgical operating instrument as recited in independent claim 1, is nowhere disclosed in Iacovelli. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by Iacovelli. Accordingly, independent

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

claim 1 patentably distinguishes over Iacovelli and is allowable. Claim 3 being dependent upon claim 1 is thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1 and 3 under 35 U.S.C. § 102(b).

Additionally, new claims 13-19 have been added. Claim 13 merges the features of original claim 1 and original claim 4, which has been indicated by the Examiner as being allowable. Claims 14-19 correspond to allowable claims 5-10 and depend from new claim 13.

Furthermore, new claim 20 has been added to further define the patentable invention. New claim 20 is fully supported in the original disclosure. Therefore, no new matter has been added by way of the addition of new claim 20.

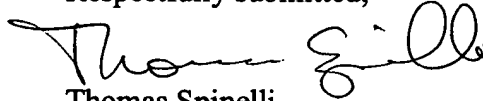
Still further, claim 2 has been amended to clarify its distinguishing features. The amendment to claim 2 is fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of the amendment to claim 2.

Lastly, the specification has been reviewed for spelling and grammatical errors as well as for inconsistencies with the drawings. Any such errors and inconsistencies have been corrected by way of the present amendment. Specifically, the specification has been amended at the paragraphs beginning at page 10, line 26 and page 11, line 9. No new matter has been entered by way of these amendments to the specification.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be

allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", with a stylized flourish at the end.

Thomas Spinelli

Registration No. 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
TS:cm